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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,678	02/25/2002	Stewart L. Atkinson	092246-9035-03	8406
23409	7590	09/20/2005	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/082,678

Applicant(s)

ATKINSON ET AL.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 14-16, 26 and 112-125 is/are pending in the application.
- 4a) Of the above claim(s) 115-119, 121 and 123-125 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 14-16, 26, 112-114, 120, 122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The Terminal Disclaimers filed on July 5, 2005, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. patent numbers 5,800,568 and 6,350,286 B1 have been reviewed and are accepted. The Terminal Disclaimers have been recorded.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 14-16, 26, 112-114, 120, and 122 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kristinsson, US 5,139,525. Figure 2 illustrates a prosthetic ankle **1** having an upper leg **9** coupled to a lower end **3** of a pylon (column 4, lines 17-18), a lower leg **10** coupled to a prosthetic foot **16-18** and **21-22**, and an interconnecting portion located between the upper and lower legs. The limiting means includes a tensioning band coupled to the upper and lower legs (via elements such as the pulley **26**: column 4, line 67 et seq.) and at least partially defines a maximum displacement between the upper and lower legs (column 5, line 1; column 6, lines 66-68; etc.). Regarding claims 26 and 120, adjusting the limiting means is discussed at column 3, lines 15-27; column 5, lines 33-36; etc.

Claims 1-4, 6, 14-16, 112, and 114 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wellershaus, US 5,156,632. The drawings show an upper leg **2a** coupled to a lower end of a pylon (via adapter **3**), a lower leg **2c** monolithically (or “integrally”) coupled to a prosthetic foot **2d** and **2e**, an interconnecting portion **2b**, and a limiting means **9** and **10** (column 4, line 64, through column 5, line 5).

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The Applicant's remarks have been reviewed. The examiner does not agree with the Applicant's position on the issue of whether an adjustment means is inherent or would have been obvious from the disclosure of Carter, US 2,453,969, because a rigid structure *can* be adjusted relative to components that are resilient and/or deformable, but the grounds of rejection based upon this patent have been withdrawn without prejudice in order to apply the "best available art" (MPEP 706.02, section I) with respect to the claims as currently amended.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**